AF/3627

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

STATEMENT OF SUBSTANCE OF INTERVIEW		Attorney Docket Number: 11032-2144 PATENT	
Reissue Applicant: Dwight Allen MERRIMAN et al.	Reissue Application No.: 09/577,798	Reissue Filing Date: May 24, 2000	
Patent Number: 5,948,061	Issued: September 7, 1999	Examiner: Harle, J	Art Unit: 3627
Invention Title: METHOD OF DELIVERY, TARGETING, AND MEASURING ADVERTISING OVER NETWORKS		Assignee: DoubleClick, Inc.	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants thank Examiner Harle and Primary Examiner Chilcot for the courtesies extended at the interview on February 12, 2003, and provide[1] this Statement of Substance of Interview in compliance with M.P.E.P. 713.04:

(A) Exhibits. No exhibit or demonstration was conducted.

(B) Claims. The pending independent claims were discussed.

(C) Prior art. Reilly (U.S. Patent No. 5,740,549), FocaLink technology (§ 102(b) reference) and the on-sale bar § 102(b) rejection were discussed.

(D) Amendments. No proposed amendments were discussed.

(E) Principal arguments of Applicants. Reilly does not teach or suggest the existence or use of a link message with ad selection as defined in the independent claims.

FocaLink technology does not select ads based upon stored information about the user node as defined in the independent claims. FocaLink technology does not select ads based on a number of times the advertising content has been previously displayed at the user node as defined in independent claims 51-57.

[1] Since a reply to the last Office action has been filed (i.e., notice of appeal filed April 28, 2003), the Interview Summary sets a one month response period from the interview date to file this statement. However, since the Interview Summary was not mailed from the Patent office until May 7, 2003, Applicants treat this mailing date as the starting point for the one month response period.

The Examiner has not established a *prima facie* case that the invention was ready for patenting at the time of the alleged sale. The alleged sale does not meet the standard set by Federal Circuit for establishing a commercial offer for sale.

The Office is also directed to the interview agenda that was submitted to Examiner Harle prior to the interview. A copy is attached hereto.

(F) Other matters. Applicants' representatives hand-delivered copies of IDS references that had been previously filed but misplaced by the Patent office. Examiner Harle agreed to consider the references.

(G) No agreement. Although no agreement was reached between Applicants' representatives and the Examiners, Examiner Harle agreed to take another look at these issues.

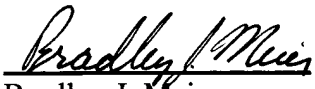
Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

KENYON & KENYON

Dated: June 9, 2003

By: 
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Examiner Harle:

Thank you for speaking with me on January 24, 2003; this is to confirm our appointment for an Office interview with you and acting SPE Rich Chilcot on Wednesday, February 12th at 1:30 p.m. to discuss U.S. Reissue Application No. 09/577,798. I propose the following agenda for our interview, to which I've included some of our discussion points corresponding to your last action:

- Discuss § 102(e) reference Reilly (U.S. Pat No 5,740,549)
  - Reilly does not teach or suggest the existence or use of a link message with ad selection as defined in the independent claims
    - Reilly displays locally stored news items and ads in a screen saver display
      - there is no link message, "inherent" or otherwise, enabling a user to "go from the news story items to the advertisements . . . within the Information database"
      - each news item and ad is a separate entity, references to which are pre-stored in a local table for the purpose of display order (see Reilly, FIG. 8)

- Discuss § 102(b) reference FocaLink technology
  - Claims 1-50
    - FocaLink technology does not select ads based upon stored information about the user node as defined in the independent claims
      - DX 93 states that post-buy, Link Performance Reports can be used to target ads
        - this type of targeting is manual; i.e., a system administrator manually alters the ad selection algorithm after reviewing the reports
        - the ensuing ad selection is based upon a pre-set configuration derived from manual review of performance reports, not stored information about an individual user node
      - DX 89 describes targeting that is based on only non-stored information, such as domain name (e.g., a ".jp" top level domain indicating a user node from Japan)
        - evaluation of domain name occurs as the ad is being requested; the domain name is not stored for later use in ad selection
  - Claims 51-57
    - FocaLink technology does not select ads based on a number of times the advertising content has been previously displayed at the user node as defined in the independent claims
      - DX 93 states that post-buy, Link Performance Reports can be used to schedule ads
        - this type of scheduling is manual; i.e., a system administrator manually alters the ad selection algorithm after reviewing the reports
        - the ensuing ad selection is based upon a pre-set configuration derived from manual review of performance reports, not ad display frequency information corresponding to an individual user node

❖ Discuss §102(b) on-sale bar rejection

➢ The Examiner has not established a *prima facie* case that the invention was ready for patenting at the time of the alleged sale

- Contrary to the Examiner's assertion that the filing of the patent application took place less than one week after the alleged sale occurred, the application was filed on October 29, *1996*, approximately a year after the alleged sale occurred. Thus, the assumption that the invention was ready for patenting because the application was filed only 5 days after the alleged sale is unwarranted.
- The Examiner's additional evidence does not show that the invention was ready for patenting at the time of the alleged sale. To the contrary, (a) the Buckingham deposition testimony at page 44 shows that Buckingham understood that targeting was not ready at that time but would be available in the future; and (b) the letter sent by Kevin O'Connor shows in numbered paragraph (3) that targeting was not ready at the time. Further, the 2-3 week timeline referred to in the letter was not for ad serving at all, but rather a different service – an email address directory.
- Moreover, the Rule 132 declaration submitted by Mr. Merriman establishes (*see* paragraph 37 *et al.*) that "the minimal amount of code necessary for the ad server to serve a targeted third-party ad over the Internet" was not done until December 1995.

➢ The alleged sale does not meet the standard set by Federal Circuit for establishing a commercial offer for sale

- O'Connor / Buckingham discussion lacked fundamental terms that would be required to establish a binding commercial contract that could be accepted by Attachmate, terms such as:
  - the type of advertisements to be provided (e.g., ads hard-coded into a web page, targeted ads to be selected and inserted real-time, or a combination of these ad types) was not specified;
  - the number of ads (and of which type) to be placed was not specified;
  - the timeframe over which the ads would be placed was not specified; and
  - the pricing structure for the ads (ad rate) was not specified
- Buckingham's deposition shows that the only specific details he recalls discussing was the overall amount he could spend ($20,000), the fact that IAN could insert non-targeted ads for Netwizard, and the fact that IAN could in the future serve targeted ads; Buckingham could not establish that the other details listed above were in fact discussed and agreed upon.
- see *Group One Ltd. v. Hallmark Cards Inc.*, 254 F.3d 1041, 1048, 59 U.S.P.Q.2d 1121, 1126 (Fed. Cir. 2001) ("Only an offer which rises to the level of a commercial offer for sale, one by which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale under §102(b).")
- see *Linear Technology Corp. v. Micrel, Inc.*, 275 F.3d 1040, 61 U.S.P.Q.2d 1225 (Fed. Cir. 2001) (no on sale bar despite occurrence of activities such as: communications about pricing information with distributors and sales representatives, including at least one discussion with a potential customer; and publication and communication of preliminary data sheets and promotional information)
- see *D&K International, Inc. v. General Binding Corp.*, 104 F. Supp.2d 958 (N.D. Ill. 2000) (meeting that included discussion of sales price but not quantity, delivery date or shipment or payment terms was not sufficient to trigger on-sale bar)

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As requested, the case law cited in Applicant's April 24, 2002 Response to Office Action is attached. And as discussed, Brian Mudge of Kenyon & Kenyon will also be in attendance. Please contact me at 202-220-4205 with any questions or comments. We look forward to meeting with you.

Respectfully Submitted,

KENYON & KENYON

By: Bradley J Meier

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